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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,886	09/18/1998	BERNHARD MUSSIG	BEIERSDORF-5	1668

7590

11/28/2001

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EXAMINER

GALLAGHER, JOHN J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 11/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/156886

Applicat(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 24 AUGUST 2001
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 37-55 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 37-55 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 17
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The disclosure is objected to because of the following informalities: The amendment to the specification at page 19 line 1 (further) needs the word "is" inserted after "claimed".

Appropriate correction is required.

2. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 37-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 (at least) of copending application Serial No. 09/114,795 (which application has been allowed and will apparently mature into a patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the same (basic) inventive concept is held to be involved in both cases, with a (very)

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substantial amount of overlap between the respective (sets of) claims. This rejection is made on the basis of "same inventive entity", with the following being additionally noted: The aforementioned claim 16 is found in the "copy of (amended) pending claims" submitted (along with a copy of the aforementioned application) as part of the IDS filed 24 August 2001; further along this line (a) these amended claims do not apparently correspond to the claims at the end of the aforementioned application (viz. method vs. article claims); and (b) with respect to (amended) claims 29-30 (in the aforementioned "copy"), NO claims 19-26 were presented.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 37-50 and 53-54 are (further) rejected under 35 U.S.C. § 103(a) as being unpatentable over either Wendler et al. or Matsui et al., each in view of either Davis or Lipman.

6. Claims 51-52 are (further) rejected under 35 U.S.C. § 103(a) as being unpatentable over either Wendler et al. or Matsui et al., each in view of either Davis or Lipman, and each further in view of the Dobashi reference.

7. Claim 55 is (further) rejected under 35 U.S.C. § 103(a) as being unpatentable over either Wendler et al. or Matsui et al., each in view of either Davis or Lipman, and each further in view of the Toppan reference.

8. Applicant's arguments filed 24 August 2001 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 4-6 of the last Office action), with the following being additionally advanced: In response to applicant's contentions made in the amendment at (a) page 3 third paragraph thru page 5 first paragraph (which are seen to be unfounded) the "less than 75 mole percent olefin" monomer limitation (which constitutes essentially the ONLY argument presented) is held to be satisfied as follows: (1) In Davis (N.B. column 1 lines 52-60), a 35/35/5 w/o propylene-butylene-1,3-butadiene terpolymer corresponds to a 53.3/^{40.3}40.3/6 mole percent terpolymer, while a 35/35/15 w/o terpolymer corresponds

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to a 47.6/35.8/16 mole percent terpolymer; and (2) in Lipman (N.B. column 1 lines 50-52 and 65-67 and column 2 lines 19-20), a 32/32/32/4 C₇ olefin-C₈ olefin-C₉ olefin-1,3butadiene terpolymer corresponds to a 34.6/30.3/27/7.9 mole percent terpolymer, all of these foregoing terpolymers being comparable/most similar to the TERpolymers set forth in the first three entries/boxes in the Table submitted on page 4 of the amendment; and (b) page 5 last line thru page 6 line 4, it has long been settled and accepted that the data presented in the specification takes precedence over any data which may be presented in a Declaration or affidavit.

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

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STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.


JJGallagher:cdc

November 7, 2001


JOHN J. GALLAGHER
PRIMARY EXAMINER
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